

Shigeharu Ushiwata et al.
Appln. No. 08/070,799

lines 19-20, the Examiner alleges that "by a distance which substantially corresponds to or is greater than" is an indefinite alternative phrase. Also, the Examiner maintains that "substantially corresponds" is indefinite, and (for the first time) that the originally presented recitation "45 degrees or more" is an indefinite alternative phrase.

Applicants vigorously disagree with the Examiner since the noted phrases are clear and definite. The use of alternative language is not per se indefinite. However, as the path of least resistance, claim 1 has been amended so as to recite that the motor shaft axis and the axis of the saw shaft are shifted by a distance which is --greater than or equal to-- the radius of the circular saw blade. Likewise, "an angle of 45 degrees or more" has been changed to --an angle greater than or equal to 45 degrees--. The recitations have been written as the mathematical expression " \geq " which can never be indefinite. In this regard, applicants point out that the previous language stated the same thing in a slightly different manner.

The Examiner's indication that claims 4 and 5 are allowable over the prior art of record is greatly appreciated.

However, the Examiner has rejected claims 1-3 under § 102(b) as anticipated by Sato et al. or, in the alternative, under 35 USC § 103 as obvious over Brickner, Jr. For the following reasons, this rejection is respectfully traversed.

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In the rejection of claims 1-3 under § 102(b) or § 103, the Examiner basically sets forth the same remarks as set forth in the previous Office Action, except that the Examiner alleges that it has been held that the functional "whereby" statement in claim 1 does not define any structure and accordingly cannot serve to distinguish.

In the paragraph bridging pages 4 and 5 of the final Office Action, with respect to applicants' argument that Sato et al. and Brickner, Jr. fail to show a motor shaft spaced from the saw shaft at a distance which substantially corresponds to the radius of the saw blade, the Examiner maintains that the recitation "substantially corresponds" is too indefinite to define over the prior art applied. Furthermore, even if a limitation directed to the distance between the axes being equal to the radius of the saw blade were incorporated into claim 1, the Examiner alleges that such a claim would still not be patentable over the prior art applied.

First, as noted above, Applicants respectfully disagree with the Examiner that the phrase "substantially corresponds" is too indefinite to define over the prior art. In particular, the recitation "corresponds to" basically means the same as "equal to". Further, the modifier "substantially" simply allows for something less than exact correspondence.

With respect to the Examiner's statement that the functional "whereby" statement does not define any structure and accordingly

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cannot serve to distinguish, it is pointed out to the Examiner that functional language is not per se objectional in claims. In particular, in determining whether a patent claim is invalid because anticipated by prior art, it is improper to disregard the preamble and all the limitations that include "adapted to", "whereby", and "thereby". Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871, 1876 (Fed. Cir. 1990). In any case, the "whereby" clause is part of the recitation of the transmission means so that the Examiner cannot simply disregard the language as he appears to have done.

Although the Examiner alleges that even if claim 1 is amended to recite that the distance between the axes is equal to the radius of the saw blade, such a claim would still not be patentable over the prior art, he has failed to articulate the reasons why this would be so. Accordingly, applicants continue to traverse the prior art rejection on the grounds that in the present invention, the motor shaft is not simply positioned above the saw shaft, but, when the saw assembly is swung up and down, the motor shaft is spaced apart from the saw shaft by a distance which is greater than or equal to the radius of the saw so that the motor shaft is located at a position where the housing is not in contact with the top surface of the base. Such a feature is not taught or suggested in Sato et al. and Brickner, Jr., whether taken alone or in combination.

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As far as the use of the term "whereby", while applicants believe that the Examiner's position is incorrect, the term "whereby" could be changed to --such that-- if desired by the Examiner, although it is believed that there is no difference in the meaning either way.

In view of the above remarks, reconsideration and allowance of this application are now believed to be in order, and such action is hereby solicited.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the local exchange number listed below.

Respectfully submitted,

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Date: November 1, 1994

PRIOR ART

FIG. 6

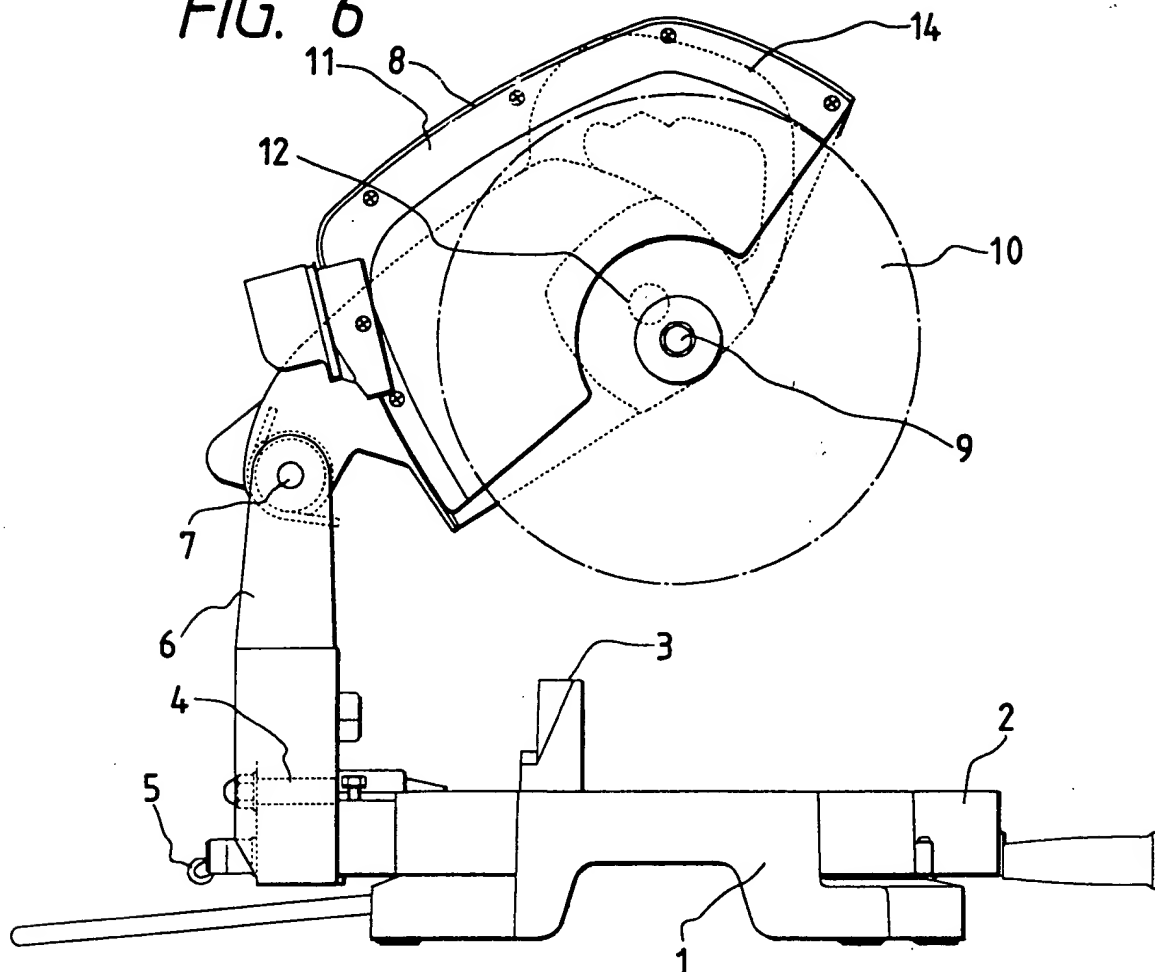


FIG. 7 PRIOR ART

